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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,069	01/28/2002	Kent B. Koller	021238-466	5441
21839	7590	10/27/2003	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			MEDINA SANABRIA, MARIBEL	
		ART UNIT	PAPER NUMBER	1754

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/868,069	KOLLER ET AL.
	Examiner Maribel Medina	Art Unit 1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 January 2002.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-47 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-47 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 17 October 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u>	6) <input type="checkbox"/> Other: _____

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**DETAILED ACTION**

**Claim Rejections - 35 USC § 112**

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 12 and 13 recite the limitation "the functional group" in line 1. There is insufficient antecedent basis for this limitation in the claim.

**Double Patenting**

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-8, 10, 12-17, 19-30, 32-45, and 47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-12, 50, 53-61, 76, 77, 79, 81-83, 85-91, 93-97, and 100-106 of U.S. Patent No. 6,209,547. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the Patent encompass the instant claims. The Patent claims are directed to a cigarette filter having as a functional group an aminopropylsilyl, method of manufacturing the filter and

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method of removal of gaseous component from a gas mixture and the instant claims are directed to a filter, method of manufacturing and method of removal of gaseous component from a gas mixture, wherein the dependent claims are directed to an aminopropylsilyl as the functional group. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the instantly claimed filter as a cigarette filter, since the instant claims are directed to any filter.

5. Claims 9, 11, 18, 1 and 46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-12, 50, 53-61, 76, 77, 79, 81-83, 85-91, 93-97, and 100-106 of U.S. Patent No. 6,209,547 in view of US Patent 4,892,719 (Gesser)

U.S. Patent No. 6,209,547 apply herein as above. U.S. Patent No. 6,209,547 fail to disclose that the filter comprises a replaceable filter element of an air ventilation system.

Gesser is relied upon to teach a replaceable filter, and method wherein aldehydes are removed from air. The filter comprises a porous material coated with a functional group (See col. 2, lines 15-26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the filter of U.S. Patent No. 6,209,547 ell et al as the replaceable filter element in Gesser filter air ventilation system since both filters are directed to the removal of aldehydes from gaseous streams.

#### **Claim Rejections - 35 USC § 102**

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 5-8, 21, 22, 26, 28-30, 34, 35, 39-41, and 45 are rejected under 35

U.S.C. 102(b) as being anticipated by US Patent No.4,300,577 (Horsewell et al).

Horsewell et al disclose a filter, method of manufacturing and method of removing a gaseous component from a gas. The filter comprises a first component (instantly claimed non-volatile inorganic substrate) and a second component (instantly claimed reactive functional group). The second component comprises amino groups and or polyethylene imine impregnated upon a carrier of porous particulate material or carried by a fibrous material such as paper or cellulose acetate, and the first component may be among others, silica gel. (See col. 1, lines 7-25 and col. 2, lines 12-48). The Filter is used to remove volatile aldehydes (Se col. 1, lines 25-26).

No difference is seen between the instantly claimed invention and Horsewell et al.

#### **Claim Rejections - 35 USC § 103**

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9, 31, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horsewell et al as applied to claims 1, 2, 5-8, 21, 22, 26, 28-30, 34, 35, 39-41, and 45 above, and further in view of US Patent 4,892,719 (Gesser)

Horsewell et al apply herein as above. Horsewell et al fail to disclose that the filter comprises a replaceable filter element of an air ventilation system.

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Gesser is relied upon to teach a replaceable filter, and method wherein aldehydes are removed from air. The filter comprises a porous material coated with a functional group (See col. 2, lines 15-26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the filter of Horsewell et al as the replaceable filter element in Gesser filter air ventilation system since both filters are directed to the removal of aldehydes from gaseous streams.

**Conclusion**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maribel Medina whose telephone number is (703) 305-1928. The examiner can normally be reached on Monday through Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (703) 308-3837. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*Maribel Medina*  
Maribel Medina  
Examiner  
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